

REMARKS

Claims 1-53 are pending in the application. Claims 13-15 and 17-53 are provisionally withdrawn from consideration. Applicant respectfully requests reconsideration of the Application in view of the foregoing amendments and the following remarks.

Claim Rejections – 35 U.S.C. § 112 (Multiplicity)

The Patent Office rejected claims 1-53 under 35 U.S.C. § 112, second paragraph, for undue multiplicity. Applicant is required to elect 3 independent claims and up to 10 dependent claims for prosecution. As required, Applicant has provisionally elected claims 1-12 and 16 for prosecution. However, Applicant respectfully traverses the rejection for at least the following reasons.

The mere fact that an application includes a larger number of claims than might be necessary to cover an invention adequately is not a sufficient reason to justify a rejection on the ground of indefiniteness for an undue multiplicity of claims. To warrant a rejection on this ground, the claims must not only be of a greater number than necessary to protect the invention, but also of a character “the net result of which is to confuse, rather than to clarify, the issues relative to an alleged improvement, which it is claimed, involves the invention.” *In re Savage*, 110 F.2d 680, 45 USPQ 155 (C.C.P.A. 1940). Consequently, if the claims are unnecessarily multiplied but are definite and clear as to the invention claimed, an indefiniteness rejection is inappropriate.

In the present case, while the number of claims presented is large, the claims do not confuse the invention. The present invention is directed to a router bit system comprised of a bit (or bits) and a bit holding assembly for attaching the bit to the drive shaft of a router without the use of additional hand tools. The bit, while designed for use with the bit holding assembly of the present invention, is also capable of being received in a standard collet-type bit holder, such as a standard router collet or the like. It is contemplated that the bit holding assembly and the bit may be produced together as part of a router, or separately by different manufacturers. Accordingly, claims 1-8 are directed to the router bit system, claims 9-15 and 42-51 are directed to the router bit holding assembly, claims 16-24 are directed to the router bit, and claims 25-32 are directed to a router employing the

router bit system. Additionally, it is contemplated that the bit system of the present invention, while most applicable to routers, may be adapted for use by other power tools which employ interchangeable bits. Accordingly, claims 34-41 are directed to a bit system not limited to use on routers. Finally, because it is desirable to invoke the protection afforded by 35 U.S.C. § 112, sixth paragraph, claims 33, 52 and 53 are written using a means plus function format. Consequently, it is believed that the claims presented, while large in number, are definite and clear as to the invention claimed and do not create confusion on the part of the reader. Withdrawal of the rejection under 35 U.S.C. § 112, second paragraph, is therefore requested.

The Patent Office has required Applicant to elect 3 independent claims and no more than 10 dependent claims for prosecution. It is noted that payment of the basic filing fees for a Utility Patent Application entitles an Applicant to 20 claims consisting of 3 independent claims and 17 dependent claims. Consequently, it would appear that it is the policy of the Patent Office that the presentation of approximately 20 claims in an application is acceptable and therefore does not constitute undue multiplicity. Consequently, it is believed that the Patent Office's requirement that Applicant elect only 3 independent claims and no more than 10 dependent claims (13 total claims) for prosecution is unreasonable. Accordingly, should Applicant's arguments presented above with respect to the rejection under 35 U.S.C. § 112, second paragraph, be rejected, Applicant hereby requests that claims 1-24 consisting of the first three independent claims and their associated dependent claims be examined.

CONCLUSION

The application is respectfully submitted to be in condition for allowance of all claims. Accordingly, notification to that effect is earnestly solicited.

Respectfully submitted,
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